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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,482	07/10/2000	Albert K. Chin	4589	1945

758 7590 10/29/2002

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EXAMINER

THALER, MICHAEL H

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/614,482

Applicant(s)

Chin

Examiner

Michael Thaler

Art Unit

3731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, drawn to a surgical apparatus, classified in class 606, subclass 170.

II. Claims 17-20, drawn to a surgical procedure, classified in class 128, subclass 898.

2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus. For example, it could be practiced by an apparatus that has a second lumen having a distal end which is distal to the distal end of the first lumen rather than intermediate the proximal and distal ends of the first lumen as defined in claim 1.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Albert Smith on October 21, 2002, a provisional election was made with traverse to prosecute the invention of group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. The disclosure is objected to because of the following informalities: On page 7, lines 8-9 indicate that lumen 124 extends through shaft 112. Yet figure 1b shows shaft 112 extending within lumen 124. Appropriate correction is required.

6. Claims 2-5, 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The surgical instrument is not part of the claimed combination as indicated by the phrase "for housing a surgical instrument" in claim 1, line 6. However, in claim 2 is inconsistent with claim 1 since it implies that the surgical instrument (the surgical scissors) is part of the claimed combination. This may be corrected by changing "houses" to "is for housing" in claim 2. In claims 11 and 14, there is no antecedent basis for "the surgical tool".

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

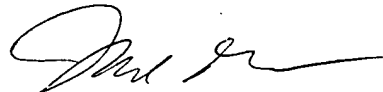
8. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scwemberger et al. (5,569,292). Scwemberger et al. show first lumen (within hollow shaft 12) for housing an endoscope therein (col. 6, lines 44-47), transparent tip 14 and second lumen (within cannula 17) for housing a surgical instrument (one of the additional instrumentation described in col. 6, lines 54-59) for performing procedures on tissue viewed (which was viewed) through the transparent tip 14 when the endoscope was present in the cannula 17. The open distal end of second lumen is obviously positioned intermediate the proximal and distal ends of the first lumen since the transparent tip 14 extends significantly distally beyond the distal end of the first lumen as seen in figures 1 and 3. As to claims 2, 3, 5, 11, 14 and 15, the surgical instrument is not part of the claimed combination as indicated in claim 1, line 6. As to claims 7-10, including a flexible hood on the distal end of the second lumen (within cannula 17) in order to seal the end of the cannula and

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yet permit an instrument to pass therethrough would have been obvious since it is well known in this art to provide such a flexible hood for this reason.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

mht  
October 22, 2002  
FAX (703) 305-3590



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731